

REMARKS

Claims 1-3, 5-7 and 20-22 were rejected under 35 U.S.C. § 103(c) as being obvious over Emmoft et al. U.S. 6,424,845 ("Emmofit") in view of Mobley et al. US Pub. No. 20030230628 ("Mobley"). Dependent Claims 4, 23, and 24 were rejected on Emmoft and Mobley and other references. Claim 1 has been amended for clarity. Support for this amendment can be found at, for example, FIG. 3 and pages 8-9 of applicant's specification. The rejections are respectfully traversed.

Applicant's independent claim 1 (as amended) is directed to a device distributed to a user as part of a solicitation. The device has at least two activation buttons, each of which are programmed with a "response mode." When a user selects a button, the device is activated in the corresponding response mode and transmits the response mode to the provider of the solicitation. The response mode indicates how the provider should respond to the user. Thus, the response mode is both (a) the user's response to the solicitation, and (b) a way for the user to indicate how the provider should corresponded with the user. In independent claim 20, when a response mode is selected by the user, it is transmitted to the provider of the solicitation, and the provider's response is provided "via the communication channel or a separate communication path ... conforming to the selected response mode."

An illustrative embodiment is shown, for example, in FIG. 4 et. seq. Focusing on FIG. 4, activation buttons 402, 404, 406 of Electronic Reply Card 400 include selectable responses: the user can press the button 402 to respond to the solicitation by asking the provider to respond by email (in this case, the consumer could be prompted to enter his/her email address as part of the response); the user can press button 404 to respond to the solicitation by asking the provider to respond by telephone (in this case, the consumer could be prompted to enter his/her telephone number as part of the response); or the user could press button 406 to respond to the solicitation by asking the provider to respond directly to the device. Thus, applicant's approach provides both the customer and the provider of the solicitation with the tools to communicate spontaneously and instantaneously, thereby enhancing the business potential of the solicitation.

Applicant respectfully submits that the combination of Emmoft and Mobley does not disclose such an approach. The Examiner rejected claim 1 construing "response mode" to be any "operating option" (see Office action p. 3). Applicant has, to promote prosecution, amended independent claim 1 with respect to the claimed "response mode" to recite the features described above. Applicant also respectfully submits, however, that the Examiner may have erroneously applied his construction of "response mode" for independent claim 1 to independent claim 20 and not given weight to the roles and functions of the response mode recited in claim 20.

In view of the amendments to claim 1, and the original language of claim 20, a prima facie case of obviousness does not exist. Applicant cannot find anything in the combination of references disclosing the claimed response mode, and the Office action points to none.¹ And, because a case of obviousness has not been made on the independent claims, dependent claims 2-7 and 21-24 are also not obvious. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). The rejections should be withdrawn. Reconsideration and allowance are respectfully requested.

Applicants believe no additional fee is due with this response other than a two-month extension of time. However, if an additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. DIIF-P01-001 from which the undersigned is authorized to draw.

Dated: May 16, 2007

Respectfully submitted,

By 

Richard M. Fenster, Jr.

Registration No.: 46,698

FISH & NEAVE IP GROUP, ROPES & GRAY
LLP

One International Place
Boston, Massachusetts 02110-2624
(617) 951-7000
(617) 951-7050 (Fax)
Attorneys/Agents For Applicant

¹ Applicant reserves the right, should prosecution continue, to present applicant's arguments concerning the lack of a motivation to combine these references, or other arguments and evidence in support of patentability.